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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,375	12/15/1999	JEAN-LOUIS GUERET	2350-76	3736

7590 01/27/2003

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/461,375	GUERET, JEAN-LOUIS
	Examiner	Art Unit
	Frank I Choi	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 1/14/2002, 4/15/2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-9, 15 and 17-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 2-26 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

The request filed on 1/14/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/461375 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restrictions

This application contains claims 10-14, 16 drawn to an invention nonelected with traverse in Paper No. 5. New claims 20-26 appear to be directed to the elected invention and will be prosecuted accordingly. Claims 2-26 are currently pending with claims 10-14, 16 withdrawn from prosecution as directed to a non-elected invention.

Specification

The abstract of the disclosure is objected to because an abstract should consist of a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-9, 15, 17-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ethylhexyl acrylate/vinyl acetate/acrylic acid copolymer, nylon or polymethyl methacrylate powders in the disclosed ranges does not reasonably provide enablement for non-ionic and non-water-swellable copolymers of acrylic/vinylic type, all fillers or having components per se without indicating amounts for the reasons of record set forth in the prior Office Actions and the further reasons below.

Examiner has duly considered Applicant's argument but deems them unpersuasive.

Contrary to Applicant's arguments, a skilled artisan would be required to do undue experimentation in order to determine whether a given filler was suitable for the claimed invention as only two types of fillers are disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-9, 15, 17-26 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00. In that paper, applicant has stated the compositions contain no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain water. Examiner has duly considered Applicant's arguments but deems them unpersuasive. In the first instance the list of solvents is contained in the preamble and not the body of the claim. In the second instance, although water is not listed as an organic solvent, the claim as a whole does not appear to exclude water.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 190 USPQ 461, 463 (CCPA 1976). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction

of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 143 USPQ 256 (CCPA 1964). MPEP Section 2111.03. Applicant does not appear to have met its burden of showing that addition of any amount of water would materially change the characteristics of its invention. As such, the rejection herein is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-9, 15, 17-22, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higo et al. (WO 96/16642) for the reasons of record set forth in the prior Office Action and the further reasons below.

Higo et al. was discussed in the prior Office Action and the same is incorporated herein.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant argues that the tackifying resin and plasticizer are excluded by the recitation "consisting essentially of". However, as indicated above, the burden is on Applicant to show that the introduction of additional steps or components would materially change the characteristics of applicant's invention; which Applicant does not appear to have met its burden. Examiner notes that although claims 20,21 mention specific fillers, the claims appear to still allow a choice between the essential oils and the specified filler.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

January 15, 2003



JOHN PAK
PRIMARY EXAMINER
GROUP 1600

